

II. General Remarks Concerning This Response

Claims 21-38 are currently pending. In this response, no
5 claims are amended; claims 21-38 are added; and claims 1-20
are canceled.

Prior art references from other co-pending patent
applications that are related to the present patent
application are being submitted in an IDS that is being mailed
10 separately from this response, which is being faxed.

Other co-pending patent applications that are related to
the present patent application have outstanding Office actions
that contain objections to the specification for numerous
typographical problems; those Office actions contain a request
15 to submit a substitute specification. Although a substitute
specification was not requested in the pending Office action
for the present patent application, a substitute specification
is being mailed separately from this response in order to
clear up any potential problems.

20 The pending Office action for the present patent
application contains an objection to the specification in
accordance with MPEP § 608.01 because the specification
contains embedded "browser-executable code", such as HyperText
Markup Language (HTML) or eXtensible Markup Language (XML)
25 tags. Applicant has not modified the specification to remove
these HTML tags because the present invention is directed to a
process or a system for manipulating such markup language
tags. As stated in MPEP § 608.01(a), if the forms of
browser-executable code are part of an applicant's invention

and it is necessary to have them included in the patent application in order to comply with the requirements of 35 U.S.C. § 112, ¶ 1, examiners should not object to such tags.

5 **III. Rejections under Provisional Double Patenting**

Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of co-pending patent application serial number 09/409,372 that is commonly
10 assigned with the present patent application. This rejection is respectfully traversed.

As a preliminary issue, it is difficult for Applicant to argue against the rejection because the rejection lacks a comparison of the specific elements of the claims in the
15 patent applications. On page 12 of the Office action, the rejection states the following in its entirety:

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent
20 granted on that copending application since the referenced copending applications and the instant application are claiming common subject, as follows:

parsing a document object model and inserting code into it based on identification of a tag, and then
25 executing the code including a method call.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending applications. See *In re Schneller*, 397
30 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

There is no reasoning nor argument comparing/contrasting the pending claims as is required in a proper obviousness-type

double patenting rejection. Applicant notes that MPEP 804 states the following:

5 Since the analysis employed in an obvious-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double
10 patenting analysis. These factual inquiries are summarized as follows:

(A) Determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue;

15 (B) Determine the differences between the scope and content of the patent claim and the prior art as determined in (A) and the claim in the application at issue;

(C) Determine the level of ordinary skill in the pertinent art; and

20 (D) Evaluate any objective indicia of nonobviousness.

The conclusion of obvious-type double patenting is made in light of these factual determinations.

25 Any obvious-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims--a claim in the patent compared to a claim in the application; and

30 (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in a patent.

35 When considering whether the invention defined in a claim of an application is an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art.

40 The pending obvious-type double patenting rejection clearly fails to meet the requirements specified by the MPEP.

It appears that the rejection was formed on the observation that the patent applications merely have some common subject matter, which is not a proper basis for rejection. The rejection merely asserts that most of the
5 claims of the present application are not patentably distinct from all of the claims in the copending patent application without providing any indication of differences between the claims in the patent applications nor any argument as to why any differences would have been obvious to one of ordinary
10 skill in the art.

Applicant argues that the pending claims in the copending patent application and the pending claims in the present application are clearly different and non-obvious with respect to the other claims. For example, one of the pending
15 independent claims of the present application, as amended, reads as follows:

21. A process for serving a web page, the process comprising the steps of:

20 prior to receiving a request for the web page, generating a Java object that implements an interface that defines a method for performing a function against an element in a Document Object Model (DOM) tree representing the web page;
in response to receiving an initial request for the web
25 page:

generating a DOM tree representing the web page;
replacing a custom tag in the DOM tree with a
script;

30 processing the DOM tree to generate a servlet having a method call that is generated as a result of processing the script, wherein execution of the method call invokes the method in the Java object;
in response to receiving the initial request or a
subsequent request for the web page:

35 executing the servlet; and
invoking the method in the Java object.

For purposes of comparison, the following recitation contains an independent claim from the other cited copending application.

5

Patent Application Serial Number 09/409,372:

11. A method for compiling a web page into an XML Document Object Model (DOM), the web page having at least first and second code blocks having script code written in different scripting languages, comprising the steps of:
- 10 examining the DOM to identify any nodes that identify a given code block;
- for each node identifying a given code block:
- creating a new node representing a Java method definition as a child node of a root element;
- 15 replacing the node that identifies the given code block with a node representing a Java method call to the Java method definition; and
- moving the given code block's child nodes under the new node representing the Java method definition.
- 20

Clearly, the pending independent claims of the present patent application are directed to a particular process for processing a DOM tree to set-up a call to a method in a Java object. In contrast, the pending claims in the copending patent application are directed to a particular process for manipulating the nodes within a DOM tree. While the subject matter is related, the claims contain very different processes.

25

With these significant differences, Applicant maintains that one of ordinary skill in the art would not have been motivated by teachings in the prior art to modify any of the claimed subject matter in the copending patent applications in such a way as to reach the pending claims of the present application without the use of hindsight facilitated by the teachings of the present application. Applicant notes that an assumption has been made that impermissible hindsight has been used in this instance because there is no additional substantive argument in the rejection.

For this and other reasons, Applicant believes that the provisional obviousness-type double patenting rejection should be withdrawn.

IV. Rejections under 35 U.S.C. § 103(a)-Obviousness

The Office action has rejected claims 1, 2, 6-9, 11, 14-17, and 20 under 35 U.S.C. § 103(a) as being unpatentable over Meltzer et al., "Market makers using documents for commerce in trading partner networks", U.S. Patent Number 6,125,391, issued 09/26/2000, filed 10/16/1998, in view of Vanhelsuwe, *Mastering JavaBeans*, 1997. The Office action has also rejected claims 3-5, 12, 13, 18, and 19 under 35 U.S.C. § 103(a) as being unpatentable over Meltzer et al. and Vanhelsuwe and further in view of Abdelnur et al., "Resources sharing on the Internet via the HTTP", U.S. Patent Number 6,212,640, issued 04/03/2001, filed 03/25/1999. These rejections are traversed.

Each of the independent claims, as amended, contains a particular sequence of steps (or means therefor) for creating

a particular Java object that is able to operate on a document object model (DOM) tree representation of a web page. Before a server receives a request for the web page from a client, a Java object is generated that implements an interface that
5 defines a method for performing a function against an element in a DOM tree representing the web page. For example, referring to the claims, this feature is recited in the first element of independent claim 21.

When an initial request for the web page is received at
10 the server, the server obtains a so-called "flat file" that contains some type of content, such as a JavaServer Page (JSP) document, and then processes the flat file to create a DOM representation of the web page (second element of claim 21). Subsequent processing steps may manipulate the DOM. In
15 particular, the content within an element that represents a custom tag within the DOM is replaced with a script (third element of claim 21). When the script is processed, a call to the method in the Java object is generated, and the method call becomes part of a servlet (fourth element of claim 21).

20 The servlet that is generated dynamically creates the output for the requested web page, which may occur during the initial request for the web page and during subsequent requests for the web page. A server can quickly and efficiently respond to these subsequent requests for the web.
25 page because an executable servlet can efficiently generate dynamic content that is embedded within the web page. During its execution, the servlet calls the method in the Java object (fifth and sixth elements of claim 21).

All of the original claims have been canceled and new claims have been substituted therefor. In particular, the content of the independent claims has been reworked to more clearly claim the present invention, and each of the
5 independent claims contains the subject matter outlined immediately above; independent claim 21 is a method claim, while independent claim 27 is a corresponding computer program product claim, and independent claim 33 is a corresponding computer system claim.

10 Applicant asserts that the applied prior art is deficient for failing to disclose the claims as amended, and these deficiencies in the rejections are sufficient to require the withdrawal of the rejections. The examiner bears the burden of establishing a *prima facie* case of obviousness based on the
15 prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24
20 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24
25 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985). In response to an assertion of obviousness by the Patent Office, the applicant may attack the Patent Office's *prima facie* determination as improperly made out, present objective evidence

tending to support a conclusion of nonobviousness, or both. In
re Fritch, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed.
Cir. 1992).

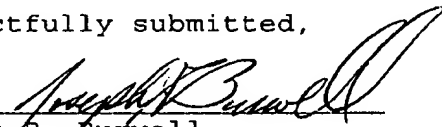
With respect to the pending claims, the rejections argue
that a combination of the applied prior art references
discloses the claimed features, but Applicant has shown above
that the applied prior art references fail to disclose the
features of the claims as amended. Hence, the rejections do
not establish a *prima facie* case of obviousness with respect to
the claims. Therefore, the rejections of all pending claims
under 35 U.S.C. § 103(a) in view of the applied prior art have
been shown to be improper, and the claims are patentable over
the applied references. Applicant requests the withdrawal of
the rejections.

V. Conclusion

For any outstanding matters or issues, the examiner is
urged to call or fax the below-listed telephone numbers to
expedite the prosecution and examination of this application.

DATE: June 21, 2003

Respectfully submitted,



Joseph R. Burwell
Reg. No. 44,468
ATTORNEY FOR APPLICANT

Law Office of Joseph R. Burwell
P.O. Box 28022
Austin, Texas 78755
Voice: 866-728-3688 (866-PATENT8)
Fax: 866-728-3680 (866-PATENT0)
Email: joe@burwell.biz

Page 17

Claussen et al. - 09/409,376